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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/645,591 | 08/22/2003 | Takatoshi Nishizawa | 240897US0CONT | 9480 |
| 22850 | 7590 | 09/27/2005 | | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER PATTERSON, MARC A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1772 | |

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,591

Applicant(s)

NISHIZAWA ET AL.

Examiner

Marc A. Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/24/03, 4/16/04, 10/25/04, 8/22/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 – 2, 7 – 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (Japanese Patent No. 2000178364) in view of Kitamura et al (U.S. Patent No. 5,834,098).

With regard to Claim 1, Tanaka discloses a label for in – mold forming (in – mold label; paragraph 0001, English translation) comprising a film comprising two layers comprising a surface layer and a heat sealing resin layer (a heat – adhesion resin laminated to a layer of a film ‘1,’ which is a surface layer as shown in Figure 1, therefore a multilayer film; paragraph 0038, English translation); the surface layer comprises a thermoplastic resin composition (thermoplastic; paragraph 0032, English translation) and a filler (paragraph 0026, English translation) and has an average surface roughness of 0.2 μm , therefore a center line average surface roughness of 0.2 μm (paragraph 0029, English translation); Tanaka does not disclose the stretching of the film, and therefore discloses a non – stretched film. Tanaka fails to disclose a filler comprising an organic filler.

Kitamura et al teach the use of a filler comprising an organic filler (column 3, lines 3 – 6) in a label for in – mold forming (column 1, lines 15 – 16) for the purpose of obtaining a label having offset printability (column 2, line 27). One of ordinary skill in the art would therefore

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have recognized the advantage of providing for the filler of Kitamura et al in Tanaka, which comprises a label for in – mold forming, depending on the desired offset printability of the end product.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for a filler comprising an organic filler in Tanaka in order to obtain a label having offset printability as taught by Kitamura et al.

With regard to Claim 2, Tanaka discloses the claimed center line average surface roughness, and the label disclosed by Tanaka therefore has an ink adhesion strength of 1 kg cm or more.

With regard to Claims 7 – 8, the claimed aspect of the surface being roughened by pressing against a textured roll is directed to a process limitation, rather than a structural limitation, and is therefore given little patentable weight.

With regard to Claim 9, the heat – sealing resin layer disclosed by Tanaka undergoes emboss processing (in carrying out the laminating of the heat adhesion resin, it is desirable to give the coating approach that embossing is performed; paragraph 0043, English translation).

With regard to Claim 11, the label disclosed by Tanaka is made of three layers (a layered product more than a bilayer; paragraph 0030, English translation) comprising a propylene resin (propylene homopolymer; paragraph 0012, English translation) and therefore comprises a central layer comprising a propylene resin.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (Japanese Patent No. 2000178364) in view of Kitamura et al (U.S. Patent No. 5,834,098) and Wolf (U.S. Patent No. 3,141,004).

Tanaka and Kitamura et al disclose a label comprising a multilayer resin film, therefore a polymer, for in – mold forming as discussed above. The film is transparent (paragraph 0029, English translation of Tanaka). Tanaka and Kitamura et al do not disclose that the film has an opacity of from 5 to 30 percent. However, Wolf discloses that a polymer (column 5, line 55) which is transparent has an opacity of below 50% (column 11, lines 9 – 11), which includes an opacity of 5%; Tanaka and Kitamura et al therefore disclose a film having an opacity of 5%.

4. Claims 4 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (Japanese Patent No. 2000178364) in view of Kitamura et al (U.S. Patent No. 5,834,098) and further in view of Ueda et al (U.S. Patent No. 5,652,326).

Tanaka and Kitamura et al disclose a film comprising two layers comprising a resin, and one layer also comprising an organic filler, as discussed above. The first layer comprises an polyolefinic resin (propylene – ethylene random copolymer; paragraph 0014, English translation of Tanaka) and the second layer comprises ethylene resin (ethylene – vinylacetate copolymer; paragraph; 0042, English translation). With regard to Claims 4 – 6, Tanaka and Kitamura et al fail to disclose a first layer comprising 94% by weight resin, 5% by weight of a permanent antistatic agent comprising polyether ester amide and 1% by weight of an organic filler and a second layer comprising 95% by weight ethylene resin and 5% by weight permanent antistatic agent comprising polyether ester amide.

Ueda et al teach the use of an antistatic agent comprising polyether ester amide (column 1, lines 15 – 16), therefore a permanent antistatic agent, in a resin in the amount of 5% by weight (3 to 40% by weight; column 2, lines 24 – 26) and a resin in the amount of 94 – 95% by weight (60 – 97% by weight; column 2, lines 24 – 26) and a filler (column 12, lines 11 – 14) for the purpose of obtaining a resin having improved antistatic property (column 2, lines 39 – 41). One of ordinary skill in the art would therefore have recognized the advantage of providing for the antistatic agent of Ueda et al in Tanaka and Kitamura et al, which comprises a resin, depending on the desired antistatic property of the end product.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for a first layer comprising 94% by weight resin, 5% by weight of a permanent antistatic agent comprising polyether ester amide and 1% by weight of an organic filler and a second layer comprising 95% by weight ethylene resin and 5% by weight permanent antistatic agent comprising polyether ester amide in Tanaka and Kitamura et al in order to obtain a resin having improved antistatic property as taught by Ueda et al.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (Japanese Patent No. 2000178364) in view of Kitamura et al (U.S. Patent No. 5,834,098) and further in view of Asano (U.S. Patent No. 4,211,690).

Tanaka and Kitamura et al disclose a propylene resin as discussed above. Tanaka and Kitamura et al fail to disclose a propylene resin having moduli of tension of from 8000 to 40,000 kgf/cm² both lengthwise and crosswise.

Asano et al teach a propylene resin (polypropylene resin; column 1, lines 55 – 57) having a modulus of tension (modulus in tension; column 1, lines 55 – 57) of from 8000 to 40,000 kgf/cm² (12,000 kg/cm²; column 1, lines 55 – 57) for the purpose of obtaining a propylene resin having rigidity sufficient to prevent deformation (column 1, lines 66 – 8; column 2, lines 1 – 3). One of ordinary skill in the art would therefore have recognized the advantage of providing for the modulus of tension of Asano in Tanaka and Kitamura et al, which comprises propylene resin, depending on the desired rigidity of the end product.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for a propylene resin having a modulus of tension of from 8000 to 40,000 kgf/cm², therefore in all directions including lengthwise and crosswise, in Tanaka and Kitamura et al, in order to obtain rigidity sufficient to prevent deformation as taught by Asano et al.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (Japanese Patent No. 2000178364) in view of Kitamura et al (U.S. Patent No. 5,834,098) and further in view of Gergen et al (U.S. Patent No. 4,085,163).

Tanaka and Kitamura et al disclose an ethylene resin as discussed above. Tanaka and Kitamura et al fail to disclose an ethylene resin having a crystallinity of 10 to 60%, a number average molecular weight of from 10,000 to 40,000 and a melting point of from 50 to 130 degrees Celsius.

Gergen teaches an ethylene resin (low density polyethylene; column 8, line 49) having a crystallinity of 10 to 60% (over 35%; column 8, lines 50 – 51), a number average molecular weight of from 10,000 (above 10,000; column 8, lines 35 – 37) and a melting point of from 50 to

130 degrees Celsius (100 degrees Celsius; column 8, lines 38 – 40) for the purpose of obtaining an ethylene resin having long term dimensional stability (column 1, lines 9 – 12). One of ordinary skill in the art would therefore have recognized the advantage of providing for the crystallinity, molecular weight and melting point of Gergen in Tanaka and Kitamura et al, which comprises an ethylene resin, depending on the desired dimensional stability of the end product.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for a crystallinity of 10 to 60%, a number average molecular weight of from 10,000 to 40,000 and a melting point of from 50 to 130 degrees Celsius in Tanaka and Kitamura et al in order to obtain an ethylene resin having long term dimensional stability as taught by Gergen.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc A Patterson whose telephone number is 571-272-1497. The examiner can normally be reached on Mon - Fri 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marc Patterson 9/19/05

Marc A. Patterson, PhD.

Examiner

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